



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,334	11/09/2001	Hidekazu Nakai	275788US6	5902

22850 7590 12/22/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SCUDERI, PHILIP S

ART UNIT PAPER NUMBER

2153

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,334

Applicant(s)

NAKAI, HIDEKAZU

Examiner

Philip S. Scuderi

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendment filed 10/25/2005. Claims 1-6 are pending.

Claim Objections

2. Claim 6 remains objected to for minor informalities. The examiner suggests the following: "a readout step of reading out ~~the~~ program information, from a recording medium having a first storage region ~~in which~~ wherein the program information ~~describing~~ describes a procedure ...".

Claim Rejections - 35 USC § 112

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 6 recites the limitation "the program information" in line 2. There is insufficient antecedent basis for this limitation in the claim. The examiner's above suggestion would correct this problem.

Response to Arguments

5. Applicant's arguments, filed 10/25/2005, with respect to Sato not disclosing all the features recited in claim 1, have been fully considered but they are not persuasive.
6. Applicant contends that Sato does not teach "a first storage region in which program information is stored with the program information describing a procedure for executing a process

Art Unit: 2153

for establishing a connection to a server over a network and downloading data from the server” or “a second storage region into which the data can be written”. The examiner respectfully disagrees.

7. Storage region 200b is a first storage region in which program information for executing a process for establishing a connection over a network is stored. “The various types of applications stored in the fixed data unit 200b are ... programs for the network connection” (Sato, paragraph 0042).

8. The network connection is used to connect to server 101 over network 100 and download data from the server. “[T]he network connection program ... connects to the server 101 through the network 100” and “receives from the server 101 various content data and other such updated information” (Sato, paragraph 0052).

9. Storage region 200d is a second storage region into which the data can be written. “[T]he central processing unit writes the downloaded various content data onto the read-capable write-capable unit 200d” (Sato, paragraph 0056).

10. Applicant’s arguments, filed 10/25/2005, in response to the rejection of claims 1-6 over Kupka in view of Hosoe have been fully considered and are persuasive. The rejection of claims 1-6 over Kupka in view of Hosoe has been withdrawn.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent

Art Unit: 2153

by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al. (U.S. 2002/0055969, hereinafter "Sato").

13. In considering claim 1, Sato discloses a recording medium [fig. 3A #200], having:

a first storage region [fig. 3A #200b] in which program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined communication network [paragraph 0042 lines 5-10] and downloading data from the connected server is stored [paragraph 0049]; and

a second storage region [fig. 3A #200d] into which the data can be written [paragraph 0049].

14. In considering claim 6, Sato discloses a download method comprising:

a readout step of reading out [paragraph 0056 lines 1-6], from a recording medium [fig. 3A #200] having a first storage region [fig. 3A #200b] in which program information describing a procedure for executing a process for establishing a connection to a predetermined network [paragraph 0042 lines 5-10] and downloading data from the connected server is stored [paragraph 0049] and a second storage region [fig. 3A #200d] into which the data can be written [paragraph 0049], the program information comprising:

an access step of accessing said server in accordance with the read out program information [paragraph 0056 lines 9-16];

Art Unit: 2153

a download step of downloading required information from said server accessed in accordance with the read out program information [paragraph 0056 lines 9-16]; and
a storage control step of storing the data acquired by the downloading into said second storage area of said storage medium [paragraph 0056 lines 9-16].

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Hosoe (U.S. 6,047,376).

17. In considering claim 2, Sato discloses the recording medium applied to claim 1. Sato does not disclose a third storage region having an ID unique to said recording medium stored therein. Nonetheless, such a feature was well known in the art, as evidenced by Hosoe. In a similar art Hosoe discloses a medium [fig. 2 #35] for downloading data [fig. 3 #S11] comprising a server access program [fig. 2 (Server Access Authentication Program)] and a storage region having an ID unique to the medium stored therein [fig. 8 (Medium ID), col. 15 lines 12-17].

18. Given the teachings of Hosoe it would have been obvious to one of ordinary skill in the art to provide the recording medium with a third storage region having an ID unique to the recording

Art Unit: 2153

medium, thereby ensuring that only clients having a legal medium are given server access [Hosoe col. 2 lines 65-67].

19. In considering claim 3, Sato-Hosoe teaches the recording medium applied to claim 2. Hosoe further discloses that the ID is used to ensure that only clients that have paid for the medium can access the server [col. 2 lines 65-67, col. 2 line 66 – col. 3 line 1]. Given the further teachings of Hosoe, it would have been obvious to ensure that only clients that have paid for the medium can access the server (i.e. manage accounting data), thereby helping to prevent profit loss.

20. In considering claim 4, Sato-Hosoe teaches the recording medium applied to claim 2. Sato discloses that various content data can be downloaded [paragraph 0056 lines 9-16]. Hosoe further discloses that the ID can be utilized by the server to identify the type of service provided [see fig. 9]. There is no reason to believe that the ID could not also be utilized to identify a type of the download data.

21. In considering claim 5, Sato-Hosoe teaches the recording medium applied to claim 2. Sato discloses that various content data can be downloaded [i.e. information from different sources (e.g. different sections of memory), paragraph 0056 lines 9-16]. Hosoe further discloses that the ID can be utilized by the server to identify the type of service provided [see fig. 9]. There is no reason to believe that the ID could not also be utilized to identify a supply source for the download.

Conclusion

Art Unit: 2153

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100